

Amendments to the Drawings

Figure 1 is amended to add the reference number 14a, denoting the first set of electrodes.
A Replacement Sheet including Figure 1 is attached.

REMARKS

I. Introduction

Claims 1-28 are currently pending in the present application. It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested. Claims 1 is amended and support can be found, for example, in the specification at page 7, paragraph 4 – page 8, paragraph 1. Claims 23-25 are amended to depend from claim 1. New claims 27 and 28 are added and support can be found, for example, in the specification at page 14, paragraph 1.

II. Rejection of Claims 1-26 Under 35 U.S.C. §103(a)

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent No. 6,015,389 to Brown (“Brown”) and U.S. Patent No. 6,363,275 to Kaiser (“Kaiser”). Applicants respectfully submit that the combination of Brown and Kaiser does not render unpatentable the present claims for at least the following reasons.

Neither Brown nor Kaiser disclose, or even suggest, all the limitations of claims 1 and 23. Brown discloses a method for monitoring respiratory conditions by impedance pneumography using two pairs of electrodes arranged around the trunk of the body. Although the Examiner asserts that “Brown clearly teaches the electrodes do not necessarily have to be arranged in a common plane and the invention can be using more than four electrodes”, Brown still fails to teach the specific arrangement of electrodes recited in claims 1 and 23. As set forth in the instant Specification, the specific arrangement of electrodes recited in claims 1 and 23, *i.e.*, having electrodes in three different specifically defined planes, provides detailed information concerning the resistivity in the measurement areas while increasing the number of independent components to calculate a particular resistivity distribution, thereby improving the resolution of the image generated thereby. *See, e.g.*, Specification, page 16, first paragraph.

The M.P.E.P. and Federal Circuit have made it clear, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03 and *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Claims 1 and 23 specifically recite a housing having a longitudinal axis; a first set of electrodes positioned in a

first plane, the first plane intersecting the longitudinal axis; a second set of electrodes positioned in a second plane, the second plane being different from the first plane and intersecting the longitudinal axis; and a third set of electrodes positioned in a third plane, the third plane intersecting the longitudinal axis between the first and second planes, and being distinct from the first plane and the second plane, wherein the third set of electrodes is rotatable around the longitudinal axis relative to the first set of electrodes and the second set of electrodes. For at least these reasons, Brown does not disclose at least the aforementioned features of claims 1 and 23. Additionally, the Examiner admits, Brown “does not teach or suggest rotating the electrodes around an axis.”

Furthermore, Kaiser fails to cure the deficiencies of Brown. Kaiser discloses a device for detecting and treating tumors using three pairs of electrodes. Kaiser clearly shows all the electrode pairs 28, 29, 30 are located in the same plane E (col 3, lines 28-38; Fig. 2). Although the carrier 19 holding the electrodes 12, 13 of the first embodiment can be rotated, this would rotate all the electrodes and would not suggest the arrangement of the present claims where the third set of electrodes is rotated *relative* to the first and second sets of electrodes. Thus, for at least these reasons, it is respectfully submitted that the combination of Brown and Kaiser does not render unpatentable claims 1 or 23 (and all claims depending therefrom).

Furthermore, there is no teaching or suggestion to combine Brown and Kaiser. A teaching or suggestion to make the claimed combination may not be based on the application's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The Examiner is using the Applicants' disclosure as a road map to make the proposed combination. As such, the present rejection is apparently based on nothing more than improper hindsight, which cannot support an obviousness rejection. Furthermore, regarding the requirement that the references must provide a suggestion or motivation for making the proposed modification, the present rejection is plainly deficient. As the Examiner is well aware from the recent Supreme Court decision in KSR v. Teleflex, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” (KSR Intern. Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007)). Rather, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to

combine the elements in the way the claimed new invention does.” (Id.) In the present case, the Examiner has provided no such reason. The Office Action contends that Brown and Kaiser are “[i]n the same field of endeavor” and that

[i]t would have therefore been obvious ... to use the teaching by Kaiser to modify the teaching by Brown for the purpose of generating a current density distribution in other planes as well for improved resolution.

Office Action, page 4. These are not suggestions or motivations for making the proposed combination but instead conclusory statements. Indeed, there is no indication whatsoever of a suggestion or motivation by Brown or Kaiser to make the proposed combination. Merely because certain references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

If the desirability of the combination cannot be found in the prior art, then a rationale must be provided that is reasoned from knowledge generally available to one of ordinary skill in the art, based on established scientific principles, or based on legal precedent established by prior case law. *See* M.P.E.P. 2144. At least a convincing line of reasoning must be presented to support the rejection. *Ex Parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985). It is respectfully submitted that the Office Action has not provided any convincing line of reasoning for making the proposed modification. Instead, as discussed above, the Office Action merely relies on conclusory statements that it would have been obvious to combine the references to achieve an end result, *i.e.*, for the purpose of generating a current density distribution, which cannot support an obviousness rejection. As such, the present rejection is apparently based on nothing more than improper hindsight, which cannot support an obviousness rejection.

As for claims 2-26, which ultimately depend from and include all of the limitations of independent claim 1, it is respectfully submitted that the combination of Brown and Kaiser does not render these dependent claims unpatentable for at least the same reasons given above in support of the patentability of independent claim 1. Additionally, it is noted that the Office Action has failed to address the majority of claim limitations recited in claims 2-26. It is respectfully submitted that the combination of Brown and Kaiser does not disclose or suggest the

additional claim limitations recited in claims 2-26. Accordingly, it is respectfully submitted that the combination of Brown and Kaiser does not render unpatentable claims 2-26.

III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Any fees for extension(s) of time or additional fees required in connection with the filing of this response, are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is authorized to charge any such required fees or to credit any overpayment to Kenyon & Kenyon's Deposit Account No. 11-0600.

Respectfully submitted,
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